

Procedures to file a request to the Industrial Property Office of the Czech Republic (IPO-CZ) for Patent Prosecution Highway Pilot Program between the IPO-CZ and the State Intellectual Property Office of the P. R. China (SIPO)

The PPH pilot program between IPO-CZ and SIPO will commence on January 1, 2018, for a trial period of 2 years. The pilot period may be extended if necessary until the SIPO and IPO receive sufficient number of PPH requests to adequately assess the feasibility of PPH program. The offices may terminate the PPH pilot program if the volume of participation exceeds manageable level, or for any other reason. Ex Ante notice will be published if the PPH pilot program is terminated.

Part I **PPH using the national work products from the SIPO**

Applicants can request accelerated examination by a prescribed procedure including submission of relevant documents on an application which is filed with the IPO-CZ and satisfies the following requirements under the IPO-CZ-SIPO Patent Prosecution Highway (PPH) pilot program based on the SIPO application.

When filing a request for the PPH pilot program, an applicant must submit a request form to the IPO-CZ.

1. Requirements

- (a) ***Both the IPO-CZ application on which PPH is requested and the SIPO application(s) forming the basis of the PPH request shall have the same earliest date (whether this be a priority date or a filing date).***

For example, the IPO-CZ application (including PCT national phase application) may be either:

(Case I) an application which validly claims priority under the Paris Convention from the SIPO application(s) (examples are provided in ANNEX I, Figures A, B, C, H, I and J), or

(Case II) an application which provides the basis of a valid priority claim under the Paris Convention for the SIPO application(s) (including PCT national phase application(s)) (examples are provided in ANNEX I, Figures D and E), or

(Case III) an application which shares a common priority document with the SIPO application(s) (including PCT national phase application(s)) (examples are provided in ANNEX I, Figures F, G, L, M and N), or

(Case IV) a PCT national phase application where both the IPO-CZ application and the

SIPO application(s) are derived from a common PCT international application having no priority claim (an example is provided in ANNEX I, Figure K).

(b) At least one corresponding application exists in the SIPO and has one or more claims that are determined to be patentable/allowable by the SIPO.

The corresponding application(s) can be the application which forms the basis of the priority claim, an application which derived from the SIPO application which forms the basis of the priority claim (e.g., a divisional application of the SIPO application or an application which claims domestic priority to the SIPO application (see Figure C in Annex I)), or an SIPO national phase application of a PCT application (see Figures J, K, L, M and N in Annex I).

Claims are “determined to be allowable/patentable” when the SIPO examiner clearly identified the claims to be allowable/patentable in the latest office action, even if the application is not granted for patent yet.

The office action includes:

- (a) Decision to Grant a Patent
- (b) First/Second/Third/…… Office Action,
- (c) Decision of Refusal,
- (d) Reexamination Decision, and
- (e) Invalidation Decision.

Claims are also “determined to be allowable/patentable” in the following circumstances: If the SIPO office action does not explicitly state that a particular claim is allowable/patentable, the applicant must include explanation accompanying the request for participation in the PPH pilot program that no rejection has been made in the SIPO office action regarding that claim, and therefore, the claim is deemed to be allowable/patentable by the SIPO.

For example, if claims are not shown in the item of “6. the Opinion on the Conclusion of Examination (审查的结论性意见) about Claims (权利要求书)” in the “First Notice of the Opinion on Examination(第一次审查意见通知书)” or “5. the Opinion on the Conclusion of Examination (审查的结论性意见) about Claims (权利要求书)” in the “Second/Third/... Notice of the Opinion on Examination(第 次审查意见通知书)” of the SIPO, those claims may be deemed to be implicitly identified to be allowable/patentable and then the applicant must include the above explanation.

(c) All claims on file, as originally filed or as amended, for examination under the PPH must sufficiently correspond to one or more of those claims indicated as allowable in the SIPO.

Claims are considered to “sufficiently correspond” where, accounting for differences due to translations and claim format, the claims in the IPO-CZ are of the same or similar scope as

the claims in the SIPO, or the claims in the IPO-CZ are narrower in scope than the claims in the SIPO. In this regard, a claim that is narrower in scope occurs when a SIPO claim is amended to be further limited by an additional feature that is supported in the specification (description and/or claims).

A claim in the IPO-CZ which introduces a new/different category of claims to those claims indicated as allowable in the SIPO is not considered to sufficiently correspond. For example, where the SIPO claims only contain claims to a process of manufacturing a product, then the claims in the IPO-CZ are not considered to sufficiently correspond if the IPO-CZ claims introduce product claims that are dependent on the corresponding process claims.

It is not necessary to include “all” claims determined to be patentable/allowable in the SIPO in an application in the IPO-CZ (the deletion of claims is allowable). For example, in the case where an application in the SIPO contains 5 claims determined to be patentable/allowable, the application in the IPO-CZ may contain only 3 of these 5 claims. Any claims amended or added after the grant of the request for participation in the PPH pilot program need not to sufficiently correspond to the claims indicated as allowable in the SIPO application.

- (d) *The IPO-CZ has not yet finished the substantive examination and has not yet invited the application to pay the administration fee for issue of the Patent letter.***
- (e) *A “Request for Substantive Examination” must have been filed at the IPO-CZ either at the time of the PPH request or previously.***

2. Documents to be submitted

Documents (a) to (d) below must be submitted by attaching to the PPH request.

- (a) *Copies of all office actions (which are relevant to substantive examination for patentability in the SIPO) which were issued for the corresponding application by the SIPO, and translations of them¹.***

Either Czech or English is acceptable as translation language. If it is impossible for the examiner to understand the translated office action, the examiner can request the applicant to resubmit translations.

¹ Machine translations will be admissible, but if it is impossible for the examiner to understand the outline of the translated office action due to insufficient translation, the examiner can request the applicant to resubmit translations.

(b) Copies of all claims determined to be patentable/allowable by the SIPO, and translations of them².

Either Czech or English is acceptable as translation language. If it is impossible for the examiner to understand the translated claims, the examiner can request the applicant to resubmit translations.

(c) Copies of references cited by the SIPO examiner

If the references are patent documents, the applicant doesn't have to submit them because the IPO-CZ usually possesses them. When the IPO-CZ does not possess the patent document, the applicant has to submit the patent document at the examiner's request. Non-patent literature must always be submitted.

The translations of the references are unnecessary.

(d) Claim correspondence table

The applicant requesting PPH must submit a claim correspondence table, which indicates how all claims in the IPO-CZ application sufficiently correspond to the patentable/allowable claims in the SIPO application.

When claims are just literal translation, the applicant can just write down that "they are the same" in the table. When claims are not just literal translation, it is necessary to explain the sufficient correspondence of each claim.

When the applicant has already submitted above documents (a) to (d) to the IPO-CZ through simultaneous or past procedures, the applicant may incorporate the documents by reference and does not have to attach them.

3. Procedure for the accelerated examination under the PPH pilot program

The IPO-CZ decides whether the application can be entitled to the status for an accelerated examination under the PPH when it receives a request with the documents stated above. When the IPO-CZ decides that the request is acceptable, the application is assigned a special status for an accelerated examination under the PPH.

In those instances where the request does not meet all the requirements set forth above, the applicant will be notified and the defects in the request will be identified. Before the issue of the notification of not assigning a special status for accelerated examination under the PPH, the applicant will be given opportunity to submit missing documents. Even after the issue of the notification of not assigning a special status for accelerated examination under the PPH, the applicant can request the PPH again.

² Machine translations will be admissible, but if it is impossible for the examiner to understand the outline of the translated claims due to insufficient translation, the examiner can request the applicant to resubmit translations.

3. PPH request form

Subject: Request for an accelerated examination under the PPH pilot program

Date of filing: _____

Application number: _____

Title of the invention: _____

Applicant: _____

Corresponding SIPO Application number: _____

Documents submitted:

Copies of all office actions (which are relevant to substantial examination for patentability in the SIPO) which were issued for the corresponding application by the SIPO and

translations of them

Copies of all claims determined to be patentable/allowable by the SIPO and

translations of them

Copies of references cited by the SIPO examiner

Claim correspondence table

Claim correspondence table		
The claim in the IPO-CZ	The patentable claim in the SIPO	Comments about the correspondence

(Documents to be omitted to submit)

Part II

PPH using the PCT international work products from the SIPO

Applicants can request accelerated examination by a prescribed procedure including submission of relevant documents on an application which is filed with the IPO-CZ and satisfies the following requirements under the IPO-CZ-SIPO Patent Prosecution Highway pilot program based on PCT international work products (PCT-PPH pilot program).

When filing a request for the PCT-PPH pilot program, an applicant must submit a request form to the IPO-CZ.

1. Requirements

The application which is filed with the IPO-CZ and on which the applicant files a request under the PCT-PPH must satisfy the following requirements:

- (1) The latest work product in the international phase of a PCT application corresponding to the application (“international work product”), namely the Written Opinion of International Search Authority (WO/ISA), the Written Opinion of International Preliminary Examination Authority (WO/IPEA) or the International Preliminary Examination Report (IPER), indicates at least one claim as patentable/allowable (from the aspect of novelty, inventive steps and industrial applicability).**

Note that the ISA and the IPEA which produced the WO/ISA, WO/IPEA and the IPER are limited to the SIPO, but, if priority is claimed, the priority claim can be to an application in any Office, see example A' in Annex II (application ZZ can be any national application).

The applicant cannot file a request under PCT-PPH on the basis of an International Search Report (ISR) only.

In case any observation is described in Box VIII of WO/ISA, WO/IPEA or IPER which forms the basis of a PCT-PPH request, the applicant must explain why the claim(s) is/are not subject to the observation irrespective of whether or not an amendment is submitted to correct the observation noted in Box VIII. The application will not be eligible for participating in PCT-PPH pilot program if the applicant does not explain why the claim(s) is/are not subject to the observation. In this regard, however, it does not affect the decision on the eligibility of the application whether the explanation is adequate and/or whether the amendment submitted overcomes the observation noted in Box VIII.

- (2) The relationship between the application and the corresponding international application satisfies one of the following requirements:**

- (A) The application is a national phase application of the corresponding international application. (See Figures A, A', and A'' in Annex II)**
- (B) The application is a national application as a basis of the priority claim of the**

corresponding international application. (See Figure B in Annex II)

(C) The application is a national phase application of an international application claiming priority from the corresponding international application. (See Figure C in Annex II)

(D) The application is a national application claiming foreign priority from the corresponding international application. (See Figure D in Annex II)

(E) The application is the derivative application (divisional application etc.) of the application which satisfies one of the above requirements (A) – (D). (See Figures E1 in Annex II)

(3) All claims on file, as originally filed or as amended, for examination under the PCT-PPH must sufficiently correspond to one or more of those claims indicated as allowable in the latest international work product of the corresponding international application.

Claims are considered to "sufficiently correspond" where, accounting for differences due to translations and claim format, the claims in the IPO-CZ are of the same or similar scope as the claims indicated as allowable in the latest international work product, or the claims in the IPO-CZ are narrower in scope than the claims indicated as allowable in the latest international work product.

In this regard, a claim that is narrower in scope occurs when a claim indicated as allowable in the latest international work product is amended to be further limited by an additional feature that is supported in the specification (description and/or claims).

A claim in the IPO-CZ which introduces a new/different category of claims to those claims indicated as allowable in the latest international work product is not considered to sufficiently correspond. For example, where the claims indicated as allowable in the latest international work product only contain claims to a process of manufacturing a product, then the claims in the IPO-CZ are not considered to sufficiently correspond if the IPO-CZ claims introduce product claims that are dependent on the corresponding process claims.

It is not necessary to include "all" claims determined to be patentable/allowable in the corresponding international application in an application in the IPO-CZ (the deletion of claims is allowable). For example, in the case where the corresponding international application contains 5 claims determined to be patentable/allowable, the application in the IPO-CZ may contain only 3 of these 5 claims.

Any claims amended or added after the grant of the request for participation in the PCT-PPH pilot program need not to sufficiently correspond to the claims indicated as allowable in the latest international work product.

(4) The IPO-CZ has not yet finished the substantive examination and has not yet invited the application to pay the administration fee for issue of the Patent letter.

- (5) A “Request for Substantive Examination” must have been filed at the IPO-CZ either at the time of the PCT-PPH request or previously.**

2. Documents to be submitted

The applicant must submit the following documents attached to the request form in filing a request under PCT-PPH. Some of the documents may not be required to submit in certain cases.

- (1) A copy of the latest international work product which indicated the claims to be patentable/allowable and their Czech or English translations if they are not in English.**

In case the application satisfies the relationship 1.(2)(A), the applicant need not submit a copy of the International Preliminary Report on Patentability (IPRP) and any English translations thereof because a copy of these documents is already contained in the file-wrapper of the application. In addition, if the copy of the latest international work product and the copy of the translation are available via “PATENTSCOPE” an applicant need not submit these documents, unless otherwise requested by the IPO-CZ.

(WO/ISA and IPER are usually available as “IPRP Chapter I” and “IPRP Chapter II” respectively in 30 months after the priority date.)

Machine translation will be admissible, but if it is impossible for the examiner to understand the outline of the latest translated international work product due to insufficient translation, the examiner can request the applicant to resubmit translations.

- (2) A copy of a set of claims which the latest international work product of the corresponding international application indicated to be patentable/allowable and their Czech or English translations if they are not in English**

If the copy of the set of claims which are indicated to be patentable/allowable is available via “PATENTSCOPE” (e.g. the international Patent Gazette has been published), an applicant need not submit this document unless otherwise requested by the IPO-CZ. Where the set of claims is written in Chinese the translations thereof must be still submitted by an applicant.

Machine translation will be admissible, but if it is impossible for the examiner to understand the outline of the latest translated claims due to insufficient translation, the examiner can request the applicant to resubmit translations.

- (3) A copy of references cited in the latest international work product of the international application corresponding to the application.**

If the reference is a patent document, the applicant is not required to submit it. In case the IPO-CZ has difficulty in obtaining the document, however, the applicant may be asked to

submit it. Non-patent literature must always be submitted. Translations of cited references are unnecessary.

(4) A claims correspondence table which indicates how all claims in the application sufficiently correspond to the claims indicated to be patentable/allowable.

When claims are just literal translation, the applicant can just write down that “they are the same” in the table. When claims are not just literal translation, it is necessary to explain the sufficient correspondence of each claim based on the criteria 1. (3) (Please refer to the Example form below).

When an applicant has already submitted the above mentioned documents (1) - (4) to the IPO-CZ through simultaneous or past procedures, the applicant may incorporate the documents by reference and is thus not required to attach the documents.

3. Procedure for the accelerated examination under the PPH pilot program

The IPO-CZ decides whether the application can be entitled to the status for an accelerated examination under the PPH when it receives a request with the documents stated above. When the IPO-CZ decides that the request is acceptable, the application is assigned a special status for an accelerated examination under the PPH.

In those instances where the request does not meet all the requirements set forth above, the applicant will be notified and the defects in the request will be identified. Before the issue of the notification of not assigning a special status for accelerated examination under the PPH, the applicant will be given opportunity to submit missing documents. Even after the issue of the notification of not assigning a special status for accelerated examination under the PPH, the applicant can request the PPH again.

3. PCT-PPH request form

Subject: Request for an accelerated examination under the PCT-PPH pilot program

Date of filing: _____

Application number: _____

Title of the invention: _____

Applicant: _____

Corresponding international application number: _____

- A copy of the latest international work product which indicated the claims to be patentable/allowable and
- their Czech or English translations if they are not in English

- A copy of a set of claims which the latest international work product of the corresponding international application indicated to be patentable/allowable and
- their Czech or English translations if they are not in English

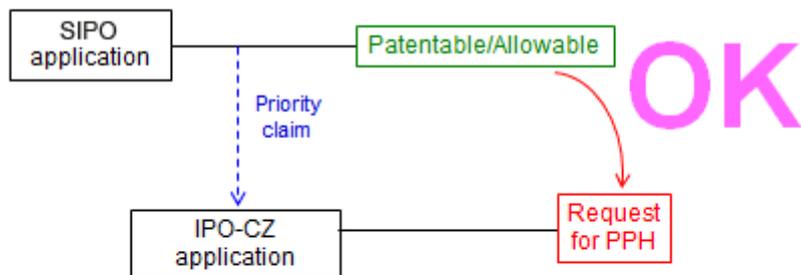
- A copy of references cited in the latest international work product of the international application corresponding to the application

- A claims correspondence table which indicates how all claims in the application sufficiently correspond to the claims indicated to be patentable/allowable

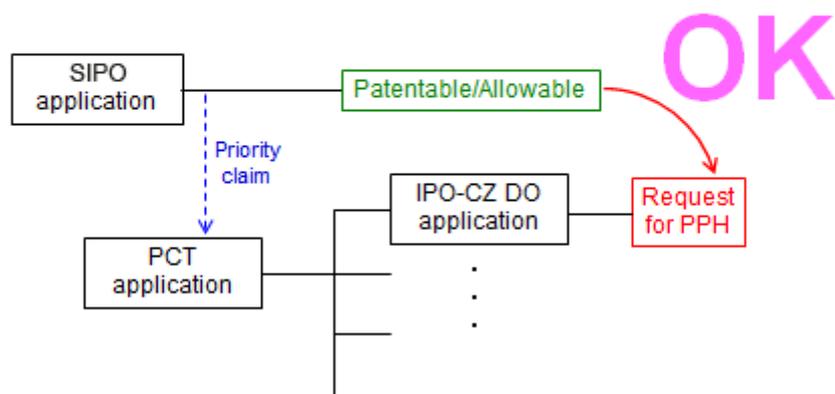
Claim correspondence table		
The claim in the IPO-CZ	The patentable claim in the international phase	Comments about the correspondence

(Documents to be omitted to submit)

A A case meeting requirement (a) (I)
- Paris route -



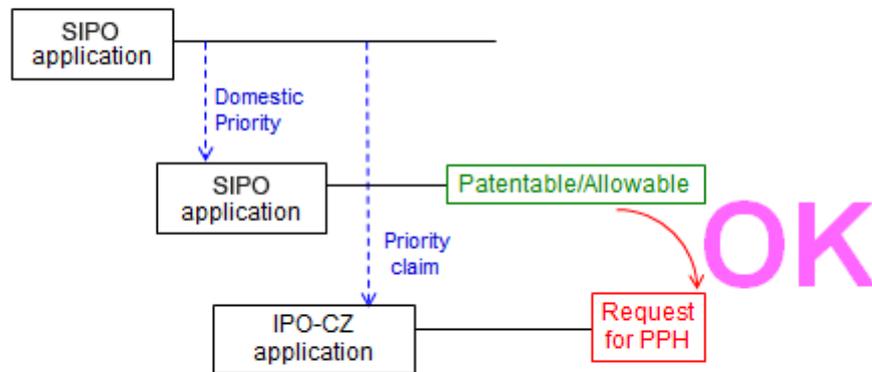
B A case meeting requirement (a) (I)
- PCT route -



C

A case meeting requirement (a) (I)

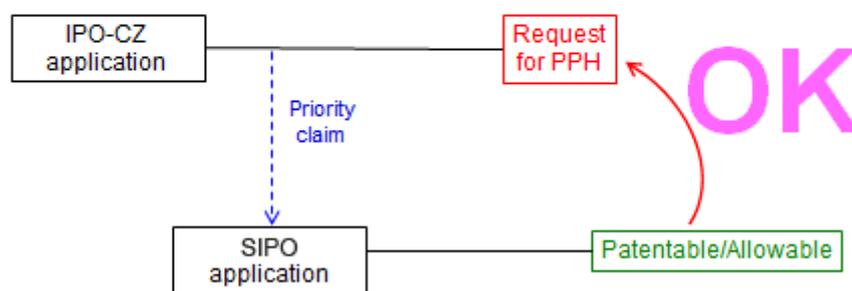
- PCT route, Domestic priority -



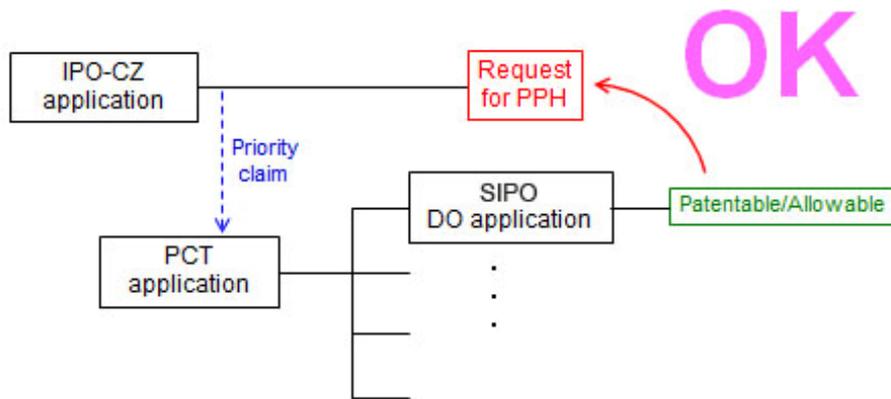
D

A case meeting requirement (a) (II)

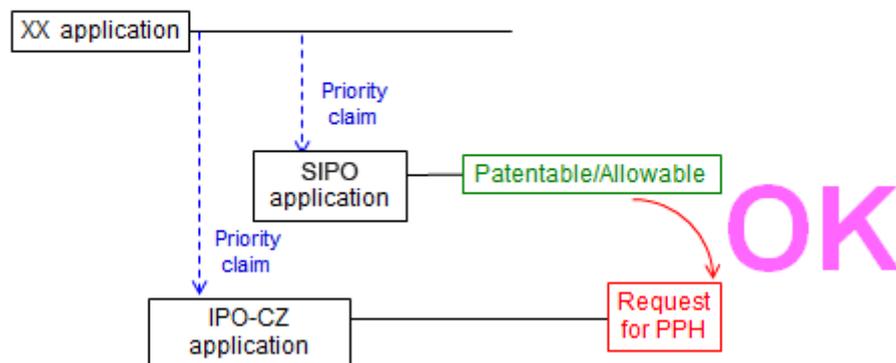
- Paris route -



E A case meeting requirement (a) (II)
- PCT route -



F A case meeting requirement (a) (III)
- Paris route, but the first application is from the third country -

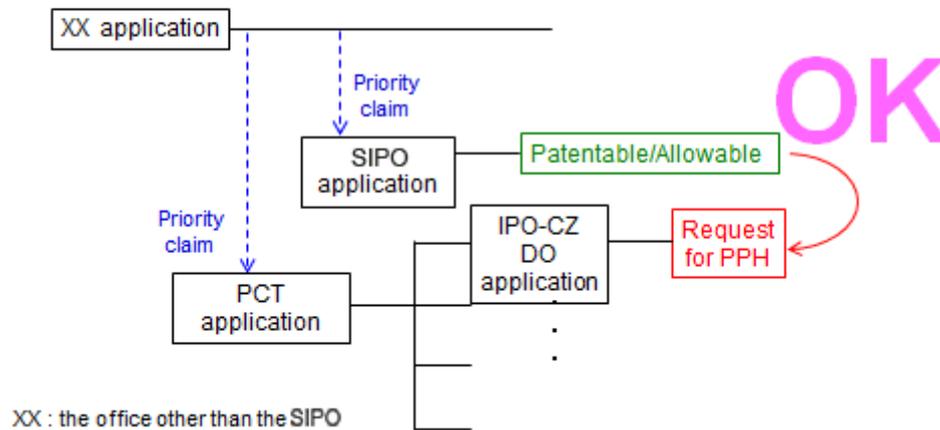


XX : the office other than the SIPO

G

A case meeting requirement (a) (III)

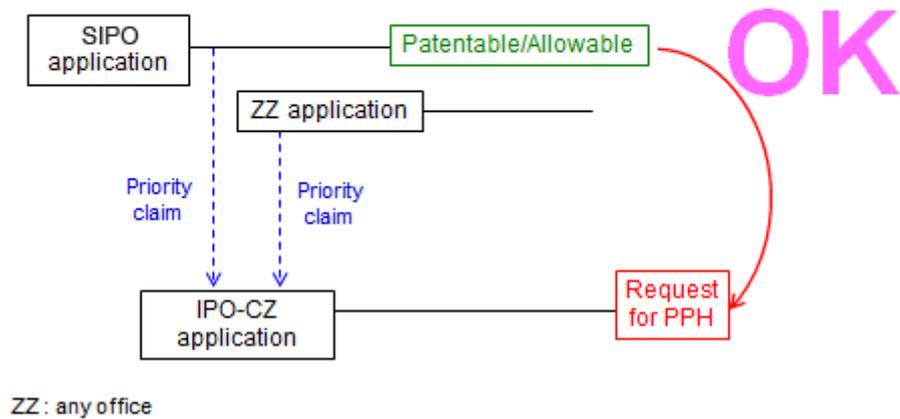
- PCT route, but the first application is from the third country -



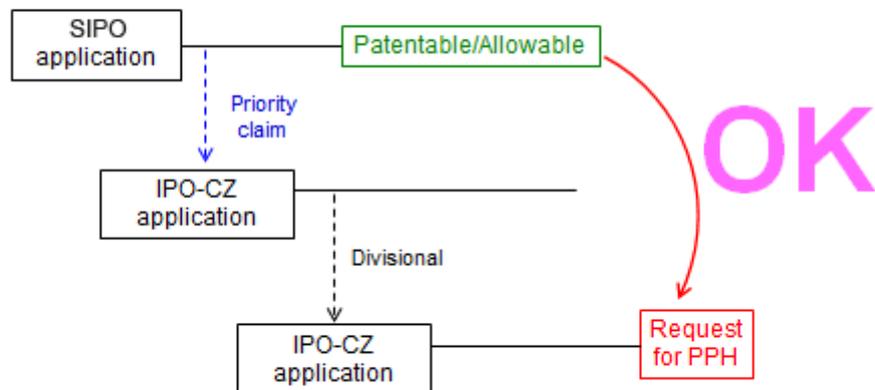
H

A case meeting requirement (a) (I)

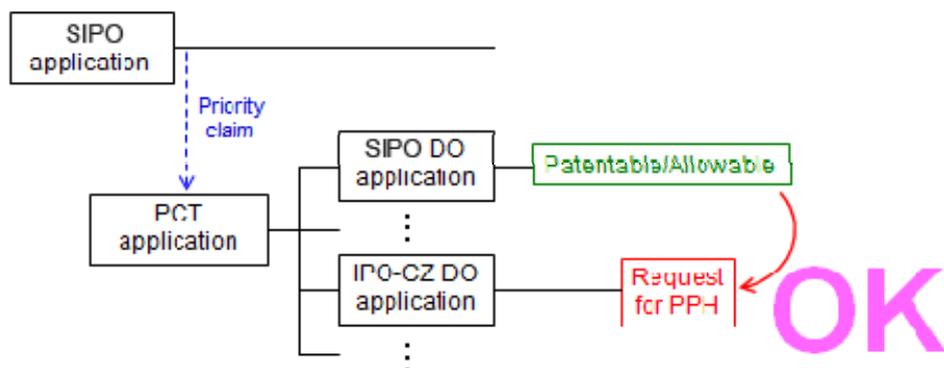
- Paris route & Complex priority -



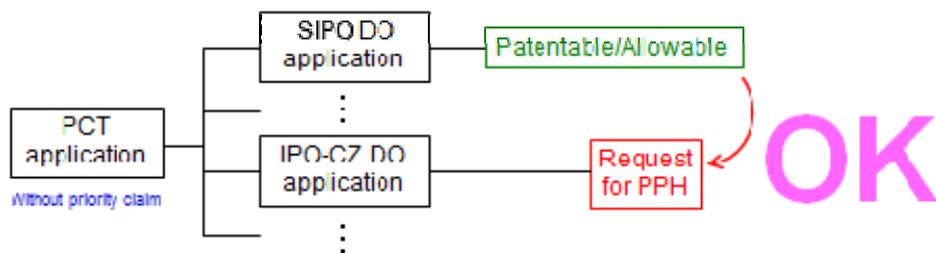
I A case meeting requirement (a) (I)
- Paris route & divisional application -



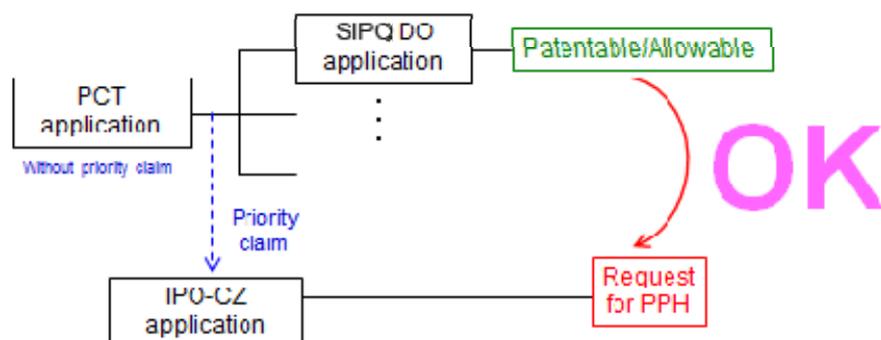
J A case meeting requirement (a) (I)
- PCT route -



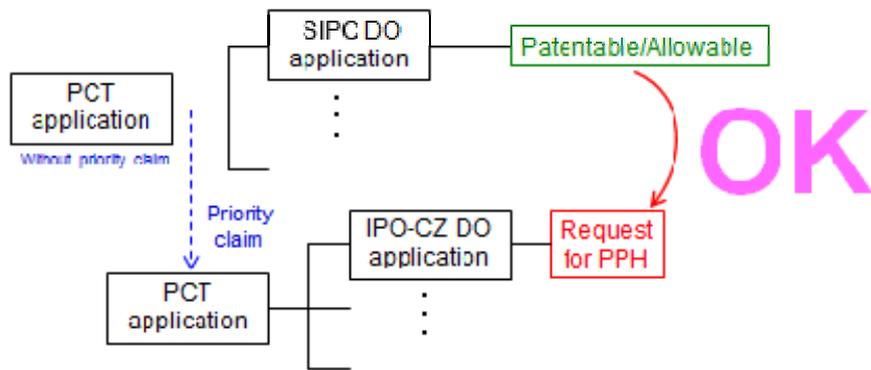
K A case meeting requirement (a) (IV)
- Direct PCT route -



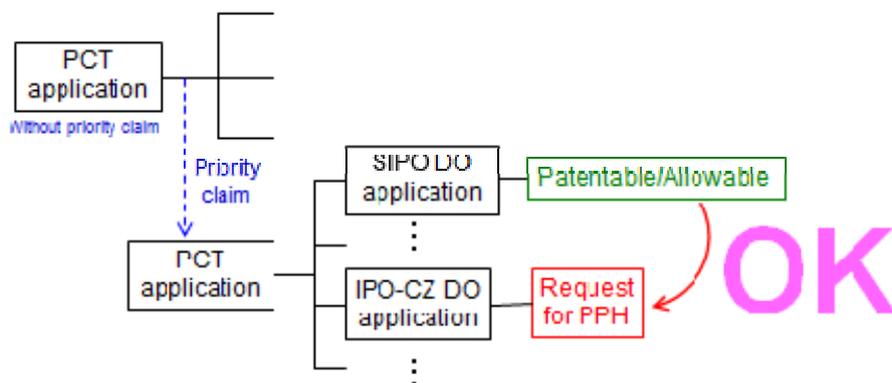
L A case meeting requirement (a) (III)
- Direct PCT & Paris route -



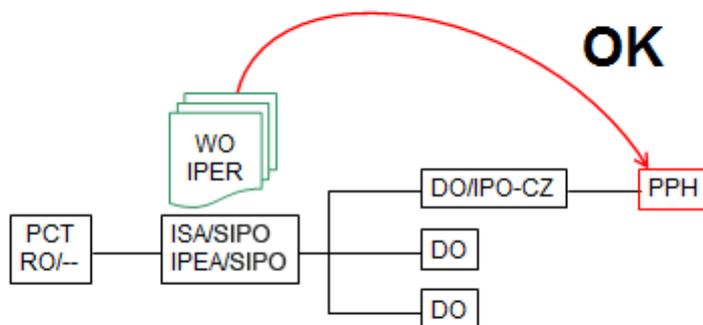
M A case meeting requirement (a) (III)
- Direct PCT & PCT route -



N A case meeting requirement (a) (III)
- Direct PCT & PCT route -

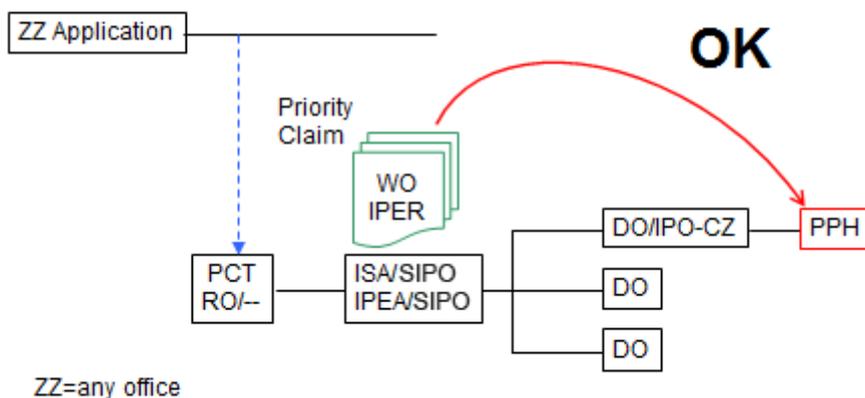


(A) The application is a national phase application of the corresponding international application.

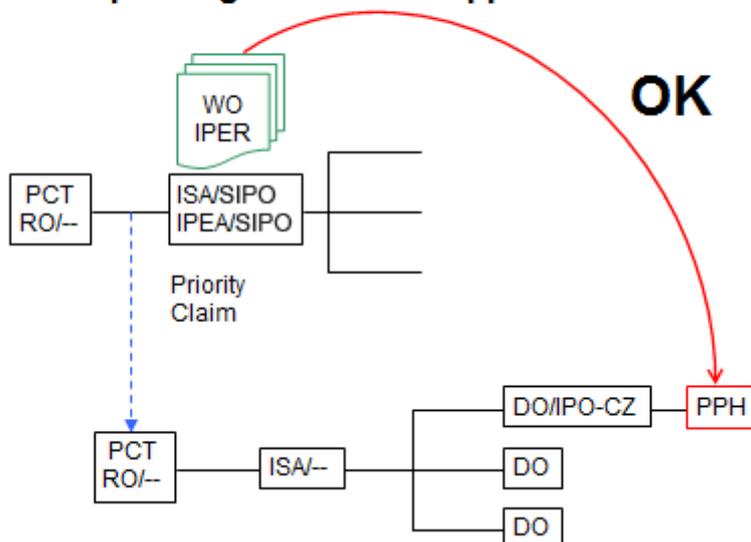


(A') The application is a national phase application of the corresponding international application.

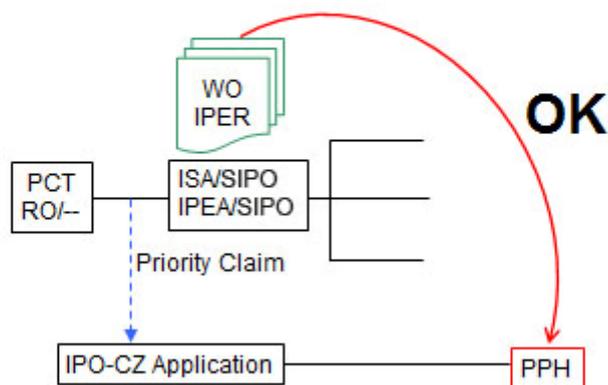
(The corresponding international application claims priority from a national application.)



- (C) The application is a national phase application of an international application claiming priority from the corresponding international application.



- (D) The application is a national application claiming foreign priority from the corresponding international application.



(E1) The application is a divisional application of an application which satisfies the requirement (A).

